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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,864	01/16/2001	Mika Partain	2271/63926	4206
7590 Ivan S. Kavrukov Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036		09/05/2007	EXAMINER GART, MATTHEW S	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 09/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/760,864	<b>Applicant(s)</b> PARTAIN ET AL.
	<b>Examiner</b> Matthew S. Gart	<b>Art Unit</b> 3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 7/12/2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 23-40 and 42-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-40 and 42-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Prosecution History Summary***

- Claims 1-22 and 41 have been canceled.
- Claims 23-40 and 42-44 are currently pending in the instant application.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 23-40 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mesaros (U.S. Patent No. 7,124,099) in view of Rubin (U.S. Patent No. 6,078,897).**

Referring to claim 23. Mesaros discloses a method for promoting product sales in Internet transaction, the method comprising:

- Providing a user interface (Mesaros: Fig. 2, "110") at a customer side for a customer to place a purchase order through the Internet to a seller side, the user interface including an ordering screen for the customer to select at least one product and enter an initial product order including information specifying a quantity of the selected product being ordered (Mesaros: column 7, lines 8-9);
- Comparing the specified quantity of the initial product order, placed by the customer side to the seller side, to a minimum quantity (Mesaros: Fig. 4, "184");
- If the specified quantity of the initial product order is equal to or greater than the minimum quantity, delivering to the customer side display information for a promotion screen containing information regarding a selected promotion which is functionally related to the initial product order and is contingent on a revision of the order to make an additional purchase (Mesaros: Fig. 13); and

- If the specified quantity of the initial product order is less than the minimum quantity, processing the initial product order received from the customer side and delivering no promotion information to the customer side (Mesaros: Fig. 14a, "520" and "525").

Mesaros does not expressly disclose a method wherein a promotion is contingent on a revision of an initial order by a customer to make an additional purchase. Rubin discloses a method wherein a promotion is contingent on a revision of an initial order by a customer to make an additional purchase (Rubin: Abstract, "The user can add one or more additional orders to the proposed order, and then submit the new proposed order.").

At the time of invention it would have been obvious to one of ordinary skill in the art to have modified the method of Mesaros to incorporate the promotion scheme of Rubin because of the complexity of some discount structures a consumer may not be aware at the time of an order that a moderately larger order can increase a discount available (Rubin: column 1, line 65 to column 2, line 17).

Referring to claim 24. Claim 24 contains limitations similar to those in claim 23. Claim 24 is rejected under the same rationale as set forth above in claim 23.

Referring to claim 25. Mesaros further discloses a method wherein if the specified quantity of the specified products is in a second range higher than the first

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range: delivering to the customer side display information indicative of at least a second promotion that is different from the first promotion (Mesaros: Fig. 4, "188" and "189").

Referring to claim 26. Mesaros does not expressly disclose wherein the first promotion is for retail sales transaction and the second promotion is for a business-to-business transaction. The Examiner notes, the "wherein" clause of claim 26 merely states the result of the limitation in the claim. The wherein clause does not relate back to or clarifies what is required by the claim and is therefore given little patentable weight. See *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001).

Referring to claim 27. Mesaros further discloses a method wherein the display information indicative of a first promotion includes information regarding a difference between the initial order quantity and a quantity for qualifying for the first promotion (Mesaros: Fig. 4, "188" and "189").

Referring to claim 28. Mesaros does not expressly disclose wherein the first promotion includes providing without charge one or more products different from the specified product. The Examiner notes, the "wherein" clause of claim 28 merely states the result of the limitation in the claim. The wherein clause does not relate back to or clarifies what is required by the claim and is therefore given little patentable weight.

See *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001).

Referring to claim 29. Mesaros further discloses a method wherein the customer side and seller side are at geographical remote locations (Mesaros: Fig. 1)

Referring to claims 30-35. Claims 30-35 contains limitations similar to those in claims 23-29. Claims 30-35 are rejected under the same rationale as set forth above in claims 23-29.

Referring to claims 36-40. Claims 36-40 contains limitations similar to those in claims 23-29. Claims 36-40 are rejected under the same rationale as set forth above in claims 23-29.

Referring to claims 42-43. Claims 42-43 contains limitations similar to those in claim 23. Claims 42-43 are rejected under the same rationale as set forth above in claim 23.

Referring to claim 44. Mesaros in view of Rubin discloses a method according to claim 23 as indicated supra. Rubin further discloses a method wherein if the customer elects to revise the order: entering information to that effect at the customer

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side that conforms to the selected promotion, whereby the initial order is no longer operative at the seller side; and executing the revised order at the seller side (Rubin: Absract).



***Response to Arguments***

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new grounds of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-272-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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